

II. REMARKS

A first non-final Office Action was issued in this application on March 17, 2009 (hereinafter “First Office Action”). This submission is believed to be fully responsive to the First Office Action. Claims 1-22 are pending in this application; all pending claims currently stand rejected. There are no amendments to the claims, specification or drawings presented herein. Thus, after entering this response, claims 1-22 remain pending. Reconsideration and reexamination of this application in view of the following remarks is respectfully requested.

A. CLAIM REJECTIONS – 35 U.S.C. 103

Claims 1-4, 10, 15 and 18-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,319,125 B1, to Acres (hereinafter “Acres”). In addition, claims 5-9, 11-14, 16, 17, 21 and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Acres in view of U.S. Patent Appl. Publ. No. 2002/0155887 A1, to Criss-Puszkiewicz et al. (hereinafter “Puszkiewicz”). Applicants respectfully traverse the pending 103(a) rejections as improper and erroneous and requests withdrawal of this rejection.

A proper rejection under 35 U.S.C. § 103(a) requires the examiner establish *prima facie* obviousness. In particular, the legal concept of *prima facie* obviousness is a procedural tool of examination which applies to all arts, allocating who has the burden, applicant or examiner, of going forward with production of evidence in each step of the examination process. See MPEP 2142. See also, In re Rinehart, 531 F.2d 1048 (CCPA 1976); In re Linter, 458 F.2d 1013 (CCPA 1972). Of notable importance, it is “[t]he examiner [who] bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.” MPEP § 2142 (emphasis in original). See In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

Similar to establishing an anticipation rejection under 35 U.S.C. § 102, to properly substantiate a *prima facie* case of obviousness under Section 103(a) requires the Examiner to provide evidentiary support for the assertion of particular teachings or suggestions claimed to be present in or arise from the prior art or knowledge in the art and each and every element and limitation of the rejected claim(s) must be treated. See In re Kotzab, 217 F.3d 1365, 1369-71 (Fed. Cir. 2000); In re Royka, 490 F.2d 981 (CCPA 1974) (“[O]bviousness requires a suggestion of all limitations in a claim.”) In setting forth a *prima facie* case, the examiner may not opportunistically

disregard certain claim language; rather, “[every] word[] in a claim must be considered in judging the patentability of a claim against the prior art.” In re Wilson, 424 F.2d 1382, 1385 (CCPA 1970). See also, In re Ochiai, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (“When determining whether a claim is obvious, an examiner must make ‘a searching comparison of the claimed invention – including all its limitations – with the teaching of the prior art.’”) As such, “rejections on obviousness cannot be sustained by mere conclusory statements”. KSR Int’l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1741 (2007), citing In re Kahn, 441 F.3d 977, 988 (CAFC 2006).

In presenting a 103(a) rejection, the reviewing examiner must provide a clear articulation, on the record, where each element and limitation of the rejected claim can be found in the prior art. See KSR Int’l Co., 127 S. Ct. at 1741. See also, MPEP 2143 (“The Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.”) Specifically, the examiner is required to point to page and line of a reference wherein each feature of a claimed invention is asserted to reside to meaningfully advance prosecution. See In re Rijckaert, 9 F.3d 1531, 1533 (Fed. Cir. 1993) (“[W]hen the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference.”); In re Yates, 663 F.2d 1054, (C.C.P.A 1981). In Ex parte Schricker, for example, the Board of Patent Appeals and Interferences vacated all pending obviousness rejections, finding that “[t]he examiner has left applicant and the board to guess as to the basis of the rejection and after having us guess would have us figure out (i.e., further guess) what part of which [prior art] document supports the rejection”. 56 USPQ2d 1723 (B.P.A.I. 2000). The Examiner has not made a *prima facie* showing of obviousness in accordance with Federal Regulations and Judicial precedent.

Independent claims 1, 10 and 18 are collectively rejected by the Examiner on the premise that Acres discloses a method of operating a wagering game, which comprises, *inter alia*, “receiving at a gaming terminal a player card that includes various media to provide information to the gaming terminal to be compared so that different functions might occur at the gaming terminal device (*see col. 4; In 20-60*).” First Office Action, at 2, ¶ 2 (emphasis in original). The Examiner goes on to acknowledge that “Acres’ [sic] does not specifically teach a first function in comparison with a first media and a second function in comparing [sic] a second media”. Id. In light of Acres failure to anticipate Applicants’ claimed invention, that Examiner proposes that:

the operation of player identification cards would store information in the memory storing data that would provide the gaming server to determine the player's eligibility for different awards and prizes (*see col. 5: ln 65-col. 6: ln 67*). As discussed in Acres' [sic] the player tracking card provides historical game play data of the specific player that will qualify the player for different progressive prizes and 'mystery' bonuses (*see col. 7: ln 10-21*).

Id., (emphasis in original).

On page 3 of the First Office Action, the Examiner goes on to observe that "several different gaming patents [discuss] player identification cards ..., [including] the media to store information on the tracking card to be in the form of magnetic strips, barcodes, or signals (ie: smart cards)." Id. Without any extrinsic evidence or other support, the Examiner thereafter determines that:

providing more than one bar code or magnetic strip would produce the expected result of storing information in different fields and would only require one of routine skill in the art. It provides no unexpected result and is but a listing of the available mediums well known in the gaming arts to be used on player tracking cards. The prior art of record teaches that this can be done using one barcode (Luciano et al. US 6,500,067), magnetic strip or signal therefore making the two 'media' separate would only take routine skill in the art. Duplicating such a media does not provide any unexpected result other than adding another storage medium to perform an operation that could just as easily be done with one.

Id. The pending 103(a) rejection of independent claims 1, 10 and 18, and thus any claims respectively depending therefrom, is improper for at least three reasons: first, the Acres reference fails to teach, explicitly or otherwise, every limitation of the rejected claims; second, the Office Action does not provide a single motivation or apparent reason why a person skilled in the art would make the Examiner's proposed modifications of Acres; and third, the pending 103(a) rejection wholly fails to address numerous limitations in the pending claims.

1. The prior art of record does not teach each and every limitation set forth in independent claims 1, 10 and 18.

Applicants' claim 1 presents "[a] method of operating a wagering game", which includes "storing data" used "for operating said wagering game" in a database, and "receiving ... a player card" that includes "first media and second media distinct from said first media". The first and second media "each provid[e] information to said gaming terminal". The method of claim 1

further comprises “performing a first function in response to comparing said information on the first media with said data; and performing a second function in response to comparing said information on the second media with said data.” The invention of claim 18 also sets forth “[a] method of operating a wagering game”, which includes limitations similar to claim 1, but instead of “performing” first and second functions, requires “using information from said first media to identify the player in [a] first database; and using information from said second media to identify the player in [a] second database.” Claim 10, on the other hand, recites “[a] gaming terminal” for playing a wagering game. The gaming terminal of claim 10 comprises, *inter alia*, “an input device for receiving a single player card from a player during said wagering game, said input device having at least one reading component for reading at least two media on said single game card”. The Examiner has not made a *prima facie* showing of obviousness of claims 1, 10 and 18 because the cited prior art fails to teach the above-highlighted limitations.

The prior art of record does not teach, suggest or otherwise disclose each and every limitation set forth in independent claims 1, 10 and 18. In a first instance, Acres does not disclose “a player card” that includes both “first media” and “second media”, wherein the “second media [is] distinct from said first media”. The Examiner contends that Acres purportedly discloses “a player card that includes various media” in Col. 4, lines 20-60. See First Office Action, at 2, ¶2. Although Acres does illustrate a player card 312 and a corresponding card reader 311 in reference FIG. 1, there is no discussion whatsoever of Acres player card 312 in Col. 4. In reality, Acres does not teach “a player card” with a “first media” that is separate and distinct from a “second media”. To that extent, the Examiner’s proposition that “making the two ‘media’ separate would only take routine skill in the art” is a mere conclusory and self-serving statement sans any supporting evidence or reasoning. Since the cited prior art does not explicitly disclose Applicants’ claimed invention, and the Examiner has not provided sufficient evidence or reasoning why the differences between Applicants’ invention and Acres is statutorily obvious, the pending 103(a) rejection of claims 1, 10 and 18 is violative of MPEP directives and judicial requirements, and must therefore be withdrawn.

In regard to claim 1, Acres also fails to suggest “performing a first function in response to comparing said information on the first media with said data; and performing a second function in response to comparing said information on the second media with said data.” In a similar respect, there is no suggestion of “using information from said first media to identify the player

in said first database; and using information from said second media to identify the player in said second database”, as required by claim 18. Finally, with respect to claim 10, Acres does not disclose “an input device” that has “at least one reading component for reading at least two media on said single game card”.

On page 2 of the First Office Action, the Examiner acknowledges that “Acres does not specifically teach” the above-highlighted limitations of claim 1. More surprisingly, the Examiner does not even discuss the above-highlighted limitations required by base claims 10 and 18. Rather than address each claim limitation and indicate where each limitation may be found in the prior art, as required by judicial mandate, the Examiner collectively dismisses claims 1, 10 and 18 as being obvious because Acres supposedly discloses somewhere in Col. 5, line 65, to Col. 6, line 67, that player identification cards “store information in the memory storing data that would provide the gaming server to determine the player’s eligibility for different awards and prizes”. Id. Moreover, the Examiner states that Col. 7, lines 10-21, of Acres teaches that “the player tracking card provides historical game play data of the specific player that will qualify the player for different progressive prizes and ‘mystery’ bonuses.” Once again, the portions of Acres cross-referenced by the Examiner – e.g., Cols. 5-7, do not touch on the player card 312 or card reader 311, let alone disclose the subject matter indicated by the Examiner. These omissions and erroneous cross-references leave Applicants to guess as to the basis of the rejection, and require Applicants to figure out (i.e., further guess) what part of the prior art supports the rejection.

Regardless of the Examiner’s improper cross-references and repeated failure to properly articulate the grounds for rejecting claims 1, 10 and 18, the record is still lacking any prior art which discloses or suggests, singly or in combination, Applicants’ claimed invention. Acres illustrates a player card 312 in FIG. 1 and a card reader 311 in FIGS. 9a-9c, and explains that “[u]pon the insertion of a card 312 into a card reader 311, the MCI 356 retrieves the player record from the DACOM host 354.” Acres, Col. 12, ll. 28-30. Thereafter, “[w]hen the card 312 is removed from the card reader 311, the parameters are sent to the DACOM host 354 for storage in the associated player record.” Id., ll.46-48. Subsequently, “[w]hen the card 312 is inserted a card reader 311 for another gaming device 300, the player record is again retrieved from the DACOM host 354 and is used by the associated MCI 356 to control the welcome back bonus 316 session.” Id., ll. 48-50.

In contrast to Applicants' invention set forth in claim 1, Acres' player card 312 does not include two separate and distinct "media", wherein Acres' gaming system/device performs "a first function in response to comparing said information on the first media with said data", and "a second function in response to comparing said information on the second media with said data." Likewise, Acres' card reader 311 is not depicted or described as including "at least one reading component for reading at least two media on [a] single game card", which is required by claim 10. Additionally, Acres network of gaming devices does not include "a first database and a second database", wherein the network uses "information from said first media to identify the player in said first database", and "information from said second media to identify the player in said second database", as required by claim 18. Because the cited prior art does not disclose all of these limitations, and the Examiner has not explained why a person skilled in the art could/would reach each of these limitations in light of Acres and the common knowledge in the art at the time of Applicants' invention, the § 103(a) rejection of all pending independent claims is insufficient, and should therefore be withdrawn.

Irrespective of independent claims 1, 10 and 18, dependent claims 3, 4, 14 and 20 are patentably distinguishable from the prior art of record. The Examiner states that "Acres teaches a method wherein the first function relates to tracking a player and the other determining access to a restricted-access progressive game (see col. 5: in 65-col. 6: in 67)." First Office Action, at 2, ¶3. (first emphasis added; second emphasis in original). Yet again, the inordinately large section of Acres cited by the Examiner fails to discuss anything remotely related to the claim limitations purportedly taught by Acres. In fact, after reviewing Acres in its entirety, Applicants submit there appears to be no depiction or discussion of "a restricted-access progressive game". Antithetically, Acres explicitly states that, "[u]nlike the other bonus promotions, no eligibility is required, no special or consolation prizes are awarded and the bonus pool 304 and hidden pool 306 are not used. Also, player eligibility is not required." Col. 9, ll. 19-22. (emphasis added).

In light of the preceding reasoning and remarks, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of claims 1-22 as being obvious, in whole or in part, over Acres.

2. The pending rejection fails to present a single motivation or apparent reason why a person skilled in the art would modify Acres as proposed by the Examiner.

According to the U.S. Supreme Court, “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” KSR International Co. v. Teleflex Inc., 127 S. Ct. 1727, 1741 (2007) (emphasis added), *citing In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) (emphasis added). The Supreme Court goes on to clarify that “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” Id. Rather, there must be “an apparent reason to combine the known elements in the fashion claimed by the patent at issue”, and such reasoning must “be made explicit.” Id., at 1742. In this regard, a mere statement that the proposed modification of the prior art to meet the claimed invention would have been within the ordinary skill of the art at the time the claimed invention was made is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. See MPEP 2143.01 (IV); Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

In summarily rejecting all of Applicants’ pending independent claims, the Examiner did not provide a single reason why a person skilled in the art, at the time of invention, would be compelled to modify Acres to reach the inventions set forth in claims 1, 10 and 18. Rather, the one paragraph rejection of claims 1, 10 and 18, presented on page 2 of the First Office Action, is purely a generalized discussion of what Acres allegedly discloses. That is, the entire rejection is directed solely towards Acres’ player card 312, and the related disclosure thereof. The one paragraph rejection does not include a single motivation, teaching, reason, suggestion, or desirability for one skilled in the art at the time of invention to modify Acres’ player card 312 to derive Applicants’ claimed “player card”. By way of example, the Examiner’s complete failure to address numerous claim limitations - i.e., “at least one reading component for reading at least two media on said single game card”, (claim 10); “using information from said first media to identify the player in said first database; and using information from said second media to identify the player in said second database renders it impossible for there to be a subsequent discussion”, (claim 18), renders it impossible to have then provided a motivation to reach such inventions.

In addition, the Examiner's assertion of mere duplication of parts is both factually deficient and legally improper. That is, the Examiner's allegation that "[d]uplicating ... media does not provide any unexpected result other than adding another storage medium to perform an operation that could just as easily be done with one", First Office Action, at 3, ¶3, lacks any fact-specific analysis and is unsupported by any evidence on the record. The relevant inquiry is not whether duplication of the parts in the abstract would have been obvious, but is rather whether it would have been obvious to one having ordinary skill in the art to additionally provide, further to the first media configured to perform the first function in the manner recited, a second media, distinct from the first media, as recited.

Further, responsive to the Examiner's assertion, apparently premised upon In re Harza, that the mere duplication of parts has no patentable significance unless a new and unexpected result is produced, ignores that Applicants' claim recitations are not a mere duplication of parts for at least the reason that the information on the second media is associated with a different function than the information on the first media, thereby providing a structure other than a mere duplication. 124 U.S.P.Q. 378 (C.C.P.A. 1960). In Ex parte Granneman, 68 USPQ2d 1219 (Bd. Pat. App. & Int. 2003), for example, the Board found that the Examiner's reliance on In re Harza as establishing a *per se* rule that duplication of parts is obvious was an incorrect statement of the law. Since In re Harza, the Federal Circuit has ruled that "reliance on *per se* rules of obviousness is legally incorrect and must cease." See e.g., In re Ochiai, 37 U.S.P.Q.2d 1127, 1133 (Fed. Cir. 1995). Accordingly, in Ex parte Granneman, the Board ruled the mere fact that the prior art could be modified as proposed by the Examiner to provide an asserted duplication is not sufficient to establish a *prima facie* case of obviousness. Rather, the Board cautioned that the Examiner must provide an explanation as to why he believed the prior art would have suggested to one of ordinary skill in the art the modification resulting in the suggested duplication.

In light of the foregoing remarks, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of claims 1-22 as being obvious, in whole or in part, over Acres.

3. The § 103(a) rejections fail to adequately articulate the grounds for rejection of numerous claims, denying Applicants an opportunity to properly respond to the rejection in full.

The Code of Federal Regulations explicitly requires “[t]he reasons for any adverse action or any objection or requirement [] be stated in an Office action” 37 C.F.R. § 1.104(a)(2). This mandate, as it pertains to the rejection of claims, is explicated in § 1.104(c)(2) of the Code, which states, *inter alia*, “[i]n rejecting claims for want of novelty or for obviousness, ... [t]he pertinence of each reference ... must be clearly explained” (Emphasis added). See KSR Int’l Co., 127 S. Ct. at 1741. Of paramount importance, MPEP directives require an examiner to “clearly articulate any rejection ... so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely” MPEP 706. As recently demonstrated by the Federal Circuit Court of Appeals panel in In re Buszard, the failure to properly articulate a rejection, through evidence and argument on the record, denying an applicant an opportunity to refute the rejection, is grounds for reversing the claim rejection. 504 F.3d 1364 (Fed. Cir. 2007). See also, Ex parte Schricker, 56 USPQ2d 1723 (B.P.A.I. 2000).

There are numerous elements and limitations in the pending claims that are not addressed by the Examiner and, more importantly, are not disclosed in the cited prior art. For example, Acres and Puskiewicz, singularly and collectively, fail to disclose: (1) “a restricted-access progressive game”, as presented in claims 3, 4, 14 and 20; (2) “an input device ... having at least one reading component for reading at least two media on said single game card”, set forth in claim 10; and (3) “using information from said first media to identify the player in [a] first database; and using information from said second media to identify the player in [a] second database”, as required by claim 18.

In addition to failing to address these limitations, the Examiner’s two-and-a-half page rejection of Applicants’ claims 1-22 is replete with errors, self-serving, conclusory statements, and improper cross-references. The Examiner fails in almost every instance to indicate where Applicants’ claim limitations are purportedly disclosed in the cited prior art references. Such practices deny Applicants an opportunity to provide evidence of patentability and otherwise reply completely. As indicated by the U.S. Supreme Court in KSR, noted by the Federal Circuit Court of Appeals in In re Buszard and In re Rijckaert, and explained by the Board of Patent

Appeals and Interferences in Ex parte Schricker, this sort of practice is reprehensible, and grounds for overturning the rejection. Accordingly, if the Examiner is to maintain that claims 1-22 are obvious in light of Acres, Applicants request, at a minimum, the pending rejections be withdrawn in favor of a properly articulated rejection on the record.

III. CONCLUSION

In light of the foregoing analysis and remarks, this submission is believed to be fully responsive to the Office Action, dated March 17, 2009. The remarks in support of the rejected claims are believed to place this application in condition for allowance, which action is herein respectfully requested. If the Examiner believes that a personal conference with Applicants' attorney will help expedite prosecution of the captioned application, the Examiner is reverently invited to contact the undersigned at his soonest convenience via the correspondence information presented below.

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The Commissioner is hereby authorized to charge any necessary fees associated with this amendment (except for payment of the issue fee) to Nixon Peabody, LLP, Deposit Account No. 50-4181, Order No. 247079-000234USPX.

Respectfully submitted,
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Date: July 16, 2009

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